



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,161	11/04/1999	TAKEO OHISHI	041-1903A	3559

7590

06/15/2004

ISRAEL GOPSTEIN  
CLARK & BRODY  
1750 K STREET NW  
SUITE 600  
WASHINGTON, DC 20006

EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 06/15/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/434,161

Applicant(s)

OHISHI ET AL.

Examiner

Vincent F. Boccio

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/5/04 & 11/3/03.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,4,14-16,20-24,28-32 and 38-44 is/are pending in the application.  
4a) Of the above claim(s) 14-16,23,24,28-32 and 38-44 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3,4 and 20-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 08/748,643.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

Art Unit: 2615

**DETAILED ACTION**  
***Response to Arguments***

1. Applicant's arguments filed 11/03/03 of the NON-Compliant amendment and the next response 4/5/04, have been fully considered but they are not persuasive.

The examiner will selectively answer the related arguments associated with the elected claims thru the restriction, thereafter election.

{A} In re page 14 of {response dated 11/3/04}, applicant states,

"It is first noted that the applied '483 reference teaches {production of clock time stamps in synchronization with PCRs and recording the time stamps}".

On the other hand as recited in claims 3-4, {produces clocks from the time stamps added to packets and record the packets together with the added time stamps}."

Art Unit: 2615

Applicant further states with respect to claims 20-22, essentially provide apparatus implementation methods recited in claims 3 & 4 and, at least for reasons similar to the foregoing, are similarly novel over the applied art.

However, it should be appreciated that claims 20 & 22, are still further differentiated from the '483 reference in that applicant's claims

"clearly define the recording locations".

In response {claims 3-4} the claims fails to recite "produces clocks from the time stamps",

but, recites,

"generating arrival time control clocks in synchronism with changes in value of time stamps for arrival time identification added to the input packets".

Wherein, the recited, "time stamps", is met by the PCR which stands for Program Clock Reference, which is a clock, therefore, "generating arrival time control clocks in synchronism with changes in value of time stamps {met by PCR} for arrival time identification, added to the input packets", which the recited claims are considered to be broader by only reciting time stamps, which are met by PCR.

In response to the statements made with respect to claims 20-22, the examiner fails to agree.

Since Fig. 4, represents a recording apparatus and corresponding method, being a tape recording medium performing sequential recording on a sequential type media, wherein as recited in claims 20-22, wherein

"the time stamps are added (Fig. 4, "ADD TIME STAMP", reference area 104/102 elements), on the storage medium (col. 10, tape record medium, also reference DRUM 106)

in order of arrivals of the packets to which the time stamps are added on the medium so that each of the packets is recorded within a given area ranging from a first position (first point, Fig. 5D or trigger point), to a second position (next 6 track reference point), across a reference position the reference being defined on one of the tracks (see Fig. 5 a-f), corresponding to an arrival time of each of the packets, the first and second positions being defined away (being a tape as recording continues time stamps are added sequentially), from the reference position (starting location) at pre-selected distance toward the tracks preceding and following (reference a mid point of Fig. 5), the one of the tracks respectively, controlling positions of the tracks formed on the medium in synchronism with the arrival time control clocks {clocks or added time stamps are generated in synchronism with a clock or PCR time stamp, see action}.

Art Unit: 2615

Wherein as understood with respect to Fig. 5 a-f, wherein Fig. 5 f, represents the counter or time stamp, wherein when comparing Fig. 5 D and Fig. 5 F, the module counter values are referenced to positions of the 6 track reference, wherein the reference is the beginning of a 6 track REFERENCE, wherein Modulo M counter, counting up {starting from a reference position track start and 6 track reference position as synchronized and resetting {counter 0-5}, after every 6 track reference signal, thereby meeting the limitation of reference position and pre-selected distance, which the counter is synchronized with respect to the track start and the 6 track reference etc., as can be seen in Figs. 5 a-f, thereby meeting the recited limitations as recited in the claims.

In conclusion the examiner maintains the same grounds of rejection in view of the arguments presented, not deemed persuasive

{B} Applicant elected species II, Fig. 8, method and apparatus claims directed toward a recording embodiment, with traverse.

Applicant states that other embodiments are closely pertinent, but fails to mention obvious over one another, therefore, considered to be distinct.

Art Unit: 2615

It is also noted that the examiner had made a rejection to numerous claims, but, had not realized applicant had provided claims directed toward multiple considered distinct embodiments, therefore, provided a restriction after realizing this issue.

Since there exists multiple distinct embodiments claimed, which is deemed serious burden on the examiner, the examiner justifies the restriction in order to focus on raised issues, by eliminating different distinct arguments with respect to different distinct species or inventions.

Further a restriction can be made at any time in during prosecution, at any time that multiple distinct invention are identified by an examiner to minimize burden and issues {arguments during prosecution and/or at a point of appeal}.

#### Claim Objections

1. Claim 20 is objected to because of the following informalities:

Claim 20 line 8, recites "arrival tune", which the examiner believes should be "arrival time", with respect to applicants disclosure and presented claims.

Appropriate correction is required.

#### Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2615

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 3-4, 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Gestal et al. (US 5,953,483).

Regarding 3-4 and 20-22, the examiner incorporates by reference the rejection from the last action.

#### **Conclusion**

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### **Contact Fax Information**

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")



Art Unit: 2615

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
6/11/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER